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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/915,719	07/25/2001	James A. Parker		6795

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EXAMINER

MANIWANG, JOSEPH R

ART UNIT PAPER NUMBER

2144

DATE MAILED: 11/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/915,719

**Applicant(s)**

PARKER, JAMES A.

**Examiner**

Joseph R Maniwang

**Art Unit**

2144

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-20, 22-37, and 39-43 is/are rejected.
- 7) ☒ Claim(s) 9, 21 and 38 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 June 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>see Office Action</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statements (IDS) submitted on 07/25/04 and 01/19/04 were in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statements were considered by the Examiner.

### ***Specification***

2. The disclosure is objected to because of the following informalities: paragraph [0009] recites "file date", which Examiner notes as a possible typographical error.
3. Appropriate correction is required.

### ***Drawings***

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: Fig 2, reference element 230 (see Specification, p. 9). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the

applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-8, 10-20, 22-37, and 39-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaguchi et al. (U.S. Pat. App. Pub. 2002/0059382), hereinafter referred to as Yamaguchi, and further in view of Kuzma (U.S. Pat. No. 5,771,355), hereinafter referred to as Kuzma.

7. Yamaguchi disclosed a method and system for transmitting e-mail messages, including a provision for controlling which recipients had access to an attached file associated with the message. Yamaguchi disclosed displaying an electronic message window (see paragraph [0041]), including a plurality of recipient fields for recording recipient addresses (see paragraph [0052], [0068]). Recipient addresses recorded in these fields identified both recipients authorized to view the attachment (see paragraphs [0046], [0047], [0049], [0051], [0060], [0067]), and recipients authorized to edit the attachment (see paragraph [0066]). Yamaguchi disclosed transmitting the message to the addresses (see paragraph [0069]), with the ability for such recipients to be grouped into at least two distinct domains (see paragraph [0103]). Yamaguchi also disclosed

Art Unit: 2144

creating address sets indicating which recipients could view or edit the attachment (see paragraph [0096]).

8. Yamaguchi did not specifically disclose transmitting data of the file separately from the electronic message.

9. In a related art of electronic messaging, Kuzma disclosed a method and system for transmitting e-mail over a network. Kuzma disclosed sending attachment files by reference, wherein the e-mail message itself comprised an attachment reference such as a hyperlink (see column 1, lines 59-61; column 5, lines 1-18; column 6, lines 17-33). Thus, Kuzma disclosed transmitting attachment data separately from an e-mail message.

10. It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Yamaguchi and Kuzma to provide a system for displaying an e-mail message window comprising a plurality of recipients fields for recording which recipient addresses were authorized to view an attachment or edit the attachment, including the provision for transmitting the attachment separately from the e-mail message as claimed. The invention of Yamaguchi generally related to the transfer of e-mail attachments to multiple recipients over a network. Kuzma similarly recognized this possibility (see column 5, lines 29-34), and also a problem associated with such a transfer as being costly and inefficient on network resources (see column 1, lines 36-52; column 3, lines 47-62; column 4, lines 52-67). The disclosed method of transmitting an attachment separately from an e-mail was described by Kuzma as a way of overcoming this problem, offering more efficient use of network resources (see

Art Unit: 2144

column 6, lines 3-7), and would have motivated one of ordinary skill in the art to consider incorporating such a feature in the invention of Yamaguchi for its added benefits.

11. Claims 1-8, 10-20, 22-37, and 39-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arnold (U.S. Pat. No. 6,275,848), hereinafter referred to as Arnold, and further in view of Yamaguchi et al (U.S. Pat. App. Pub. 2002/005382), hereinafter referred to as Yamaguchi.

12. Arnold disclosed a method and system for transmitting e-mail messages, providing an automated attachment processor which remotely stored an attachment and embedded a pointer, such as a hyperlink, in the e-mail message referencing the attachment (see column 2, lines 42-50; column 3, lines 57-62; column 4, lines 30-42), thus sending an attachment separately from an e-mail message. A recipient of the e-mail could then display an e-mail client window for reading the message and accessing the attachment reference (see column 5, lines 7-24). Access to an attachment could be controlled using an access list (see column 2, lines 56-61; column 3, lines 62-66; column 4, lines 25-28, 43-46). Arnold disclosed that the access rights defined for a recipient by the access list could control which recipients were able to view an attachment or edit an attachment (see column 5, lines 36-50). The access list could be modified, preferably by the sender of the e-mail, to reflect which intended recipients had access to the attachment (see column 4, lines 51-54; column 5, lines 51-57).

Art Unit: 2144

13. While Arnold disclosed the use of an access list for defining which recipients of an e-mail message could view or edit a separately transmitted attachment, Arnold did not specifically disclose defining which recipients were authorized to view or edit the attachment by recording in a plurality of fields recipient addresses identifying such authorized recipients.

14. In a related art of electronic messaging, Yamaguchi disclosed a method and system for transmitting e-mail messages, including a provision for controlling which recipients had access to an attached file associated with the message. Yamaguchi disclosed displaying an electronic message window (see paragraph [0041]), including a plurality of recipient fields for recording recipient addresses (see paragraph [0052], [0068]). Recipient addresses recorded in these fields identified both recipients authorized to view the attachment (see paragraphs [0046], [0047], [0049], [0051], [0060], [0067]), and recipients authorized to edit the attachment (see paragraph [0066]). Yamaguchi disclosed transmitting the message to the addresses (see paragraph [0069]), with the ability for such recipients to be grouped into at least two distinct domains (see paragraph [0103]). Yamaguchi also disclosed creating address sets indicating which recipients could view or edit the attachment (see paragraph [0096]).

15. It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Arnold and Yamaguchi to provide a system in which an e-mail attachment was sent separately from the message to a plurality of users, including a provision for controlling access to the attachment through the use of an access list defined by recording in a plurality of address fields which recipient

Art Unit: 2144

addresses were authorized to view or edit the file as claimed. Arnold provided clear teachings relating to the broad concept of controlling access to an attachment, and while not specifically disclosing the use of address fields for define such access rights, disclosed the possibility to use other means and "other configurable criteria" for defining and modifying the access list (see column 3, lines 62-64; column 6, lines 1-6), thus motivating one of ordinary skill in the art to search for other teachings on ways to define access to an attachment. As noted above, Yamaguchi disclosed such an alternative means for defining access rights through the use of a plurality of address fields recording which recipient addresses were authorized to view or edit an attachment. One of ordinary skill in the art would have been motivated by Yamaguchi to consider such a feature as it solved a similar problem recognized by Arnold, and could also be implemented easily without change to existing e-mail servers (see paragraph [0014], [0015]).

### ***Claim Objections***

Claims 9, 21, and 38 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.



Beck et al. (U.S. Pat. No. 5,903,723) disclosed a method and system for transmitting e-mail attachments by reference using an embedded hyperlink.

Watanabe (U.S. Pat. No. 6,327,612) disclosed an e-mail system for selectively transmitting attachments to TO: address and not CC:/BCC: addresses.

Baker et al. (U.S. Pat. App. Pub. 2004/0049696) disclosed an e-mail system based on privileges.

Soroker et al. (U.S. Pat. App. Pub. 2002/0112010) disclosed a method for processing e-mail messages having an attachment.

Ruppert et al. (U.S. Pat. App. Pub. 2001/0054073) disclosed an e-mail system for replacing an attachment with a link.

Collins et al. (U.S. Pat. App. Pub. 2002/0013817) disclosed a method and system for transmitting e-mail to a plurality of recipients classified as receiving an attachment or not.

Kohler (U.S. Pat. No. 6,192,396) disclosed a system for transmitting e-mail with recipient specific content.

Prahlad et al. (U.S. Pat. App. Pub. 2001/0047389) disclosed an e-mail management system for storing e-mail and associated attachments separately.

Marchionda (U.S. Pat. No. 6,628,306) disclosed an e-mail client for designating which recipients could receive an attachment.

Rice, III (U.S. Pat. App. Pub. 2002/0174010) disclosed a computer system for removing attachments and storing them on a server.

Pollack (U.S. Pat. No. 6,505,236) disclosed a network-based attachment storage system.


Beyda et al. (U.S. Pat. No. 6,275,850) disclosed an e-mail system for filtering attached files based on a number of criteria.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph R Maniwang whose telephone number is (703) 305-3179. The examiner can normally be reached on Mon-Fri 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William A Cuchlinski can be reached on (703)308-3873. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JM

  
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